

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 2-7, 10, and 14-20 are pending.

The outstanding Official Action rejected Claims 2-7, 10, and 14-20 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,168,442 to Naoi in view of U.S. Patent No. 6,184,460 to Bertoncini.

Applicants respectfully traverse the rejection of the pending claims under 35 U.S.C. § 103(a) on the grounds that the outstanding Official Action does not set forth a *prima facie* case of obviousness.

MPEP § 706.02(j) notes that to establish a *prima facie* case of obviousness, there must be a *reasonable expectation of success* when two or more references are combined. The anisotropically conductive sheet in Naoi is quite different from the conducting device disclosed in Bertoncini in their specific structures. More particularly, it would be impossible to combine the electrical shielding as disclosed in Bertoncini with the anisotropically conductive sheet disclosed in Naoi because the electrical shielding of Bertoncini would hinder the intended deformation of the anisotropically conductive sheet of Naoi. Thus, combining Bertoncini with Naoi would render the anisotropically conductive sheet of Naoi *inoperative*. Therefore, Applicants respectfully submit that a *prima facie* case of obviousness has not been set forth because combining the electrical shielding of Bertoncini with the anisotropically conductive sheet of Naoi would not lead to a *reasonable expectation of success*.

However, to further prosecution, Applicants amend Claims 2-6 to overcome the rejections under 35 U.S.C. § 103(a). Claims 2-6 are amended to recite that: (1) “the elastic

anisotropically conductive film is composed of an elastic polymeric substance”;¹ (2) “in each of the conductive parts and each of the conductive parts for high-frequency shielding, conductive particles are contained in the elastic polymeric substance in a state oriented so as to align in the thickness-wise direction of the film”;² and (3) “the insulating part is substantially free of conductive particles.”³

By placing conductive parts for high frequency shielding extending in the same direction as the conductive parts for connection in the elastic anisotropically conductive film, the external noises to high frequency signals and noises from adjoining conductive parts for connection can be controlled in each of the conductive parts for connection by connecting the conductive parts for high frequency shielding to a ground.⁴ Thus, the claimed invention allows an electrical inspection of a circuit device with clock frequencies as high as 1 GHz.⁵

Figure 1 of Naoi illustrates an anisotropic conductivity sheet 11 having conductive portions (12), an insulating portion (8), and a positioning metal plate (16).⁶ Naoi describes using the conductive portions (12) of the sheet (11) for connection to electrodes,⁷ while high-frequency shielding is achieved by connecting the metal plate (16) to ground.⁸ Naoi neither discloses nor suggests that the conductive portions (12) or the metal plate (16) contain *conductive particles in a state oriented so as to align in the thickness-wise direction of the sheet (11).*

¹ See specification at page 21, lines 2-3.

² See specification at page 28, lines 18-24.

³ See specification at page 28, lines 24-26.

⁴ Specification at page 12, lines 15-24.

⁵ Specification at page 12, line 24, to page 13, line 3.

⁶ See Naoi at col. 4, lines 16-22.

⁷ See Naoi column 5, lines 36-40.

⁸ See Naoi column 3, lines 8-12.

Bertoncini describes a series of shield modules assembled in a stacked relationship.⁹ Each module defines shield cavities A, B, and C,¹⁰ where each cavity is defined by at least three walls.¹¹ Furthermore, each module includes a conductor (56) surrounded by a bore (40) with a gap (58) in-between filled with electrically insulating material.¹² Shielding is provided by connecting leads (46, 48, and 50) to the same ground potential. Bertoncini neither discloses nor suggests that the shielding modules are formed by *conductive particles contained in an elastic polymeric substance in a state oriented so as to align in the thicknesswise direction in which the conductive parts for connection is extended*.

Accordingly, Applicants respectfully submit that Naoi and Bertoncini fail to disclose or suggest all the claimed limitations of Claims 2-6 as amended. Therefore, Applicants respectfully submit the rejections of Claims 2-6, and claims depending therefrom, are rendered moot by the present amendment.

⁹ See Bertoncini at col. 3, lines 48-52 and Figure 1.

¹⁰ See Bertoncini at Figure 1.

¹¹ See Bertoncini at col. 3, lines 51-65

¹² See Bertoncini at col. 4, lines 34-39 and Figure 1.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the present invention is in condition for formal allowance and an early and favorable action to that effect is respectfully submitted.

Respectfully submitted,

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